



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.:	6,949,245	Group Art Unit:	1642
Serial no.:	09/602,812	Examiner:	A.L. Holleran
Confirmation No.:	9612		
Filed:	23 June 2000		
Inventor:	Mark Sliwkowski		
For:	Humanized anti-ErbB2 antibodies and treatment with anti-ErbB2 antibodies		

REQUEST FOR RECONSIDERATION OF REVISION OF
PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Mail Stop **Petitions**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The owner of U.S. Patent No. 6,949,245 requests reconsideration of the revised determination of patent term adjustment as reflected in PAIR following the grant of the patent. This request is filed on the first business day following the date that is two months from the date of the patent grant (the two-month date falling on a Sunday) and is therefore timely.

The Director is requested to debit the fee specified at 37 C.F.R. § 1.18(f) (\$400), as well as any other fee as may be required in connection with this request, to the undersigned's Deposit Account No. 18-1260.

12/06/2005 CNGUYEN1 00000049 181260 6949245

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Facts

1. U.S. Patent No. 6,949,245 was filed as application serial no. 09/602,812 on 23 June 2000 and was issued on 27 September 2005.
2. The patent was granted with a net PTA of 215 days, calculated as +253 days of PTO delay, -612 days of applicant delay, and +574 days of three-year delay.
3. None of the occurrences enumerated at 37 C.F.R. § 1.702(b)(1)-(4) occurred in the prosecution of this application. This patent is not subject to a terminal disclaimer.
4. Patentee filed an application for reconsideration of the Office's initial determination of PTA under 37 C.F.R. § 1.705(b) on 12 April 2005. In a decision on a concurrently-filed petition under § 1.183 mailed on 18 August 2005, the request for reconsideration was dismissed as not timely filed.
5. In view of the decision dismissing patentee's earlier request for reconsideration, patentee does not contest the Office's determination of the following factors contributing to net PTA that were entered in the PAIR database prior to 12 April 2005, as shown in the printout attached to this request (and enumerated with specificity in the request under § 1.705(b) filed on 12 April 2005, which paper is incorporated by reference):
 - Applicant delay, total 492 days
 - Office delay, total 253 days
6. The following entries appearing in the Office's calculation of PTA were posted to the PAIR database on or after 12 April 2005:
 - "PTA 36 months," for the length of application pendency exceeding 3 years, 574 days of PTO delay
 - "Patent issue date used in PTA calculation," for the interval exceeding 4 months between the payment of the issue fee and the patent grant, 50 days of PTO delay
 - For a "miscellaneous incoming paper" filed on 12 April 2005, 120 days of applicant delay.

7. Patentee has not identified an error in the Office's entries for "PTA 36 months" and "Patent issue date ..." delays.
8. For the reasons discussed below, patentee believes that the 120-day applicant delay associated with the "miscellaneous paper" filed on 12 April 2005 was recorded in error. Thus, patentee believes that the correct net PTA for this patent should be +335 days.

Discussion

It is not clear to patentee why any applicant delay is associated with the papers filed on 12 April 2005. The only papers filed on that date were (1) an application for patent term adjustment under 37 C.F.R. § 1.705(b), with attachments; and (2) a petition under 37 C.F.R. § 1.183 requesting waiver of the requirement that an application for patent term adjustment be filed before the payment of the issue fee (the issue fee having been paid on 8 April 2005).

The undersigned spoke with Nancy Johnson in the Office of Petitions to review the PTA calculation for this application. It was her impression that the 120 days of applicant delay entered on 12 April 2005 appeared to correspond to the filing of applicant's application under § 1.705(b).

If the 12 April entry does in fact relate to patentee's submission under § 1.705(b), then the delay is charged in error. 37 C.F.R. § 1.704(e) provides expressly that a submission under § 1.705(b) does not constitute a failure by the applicant to engage in reasonable efforts to conclude prosecution of the application.

If the 12 April entry corresponds to the petition under 37 C.F.R. § 1.183 filed on that date, patentee does not believe that a delay is appropriately charged against applicant. It is patentee's understanding that post-allowance processing was not delayed pending a decision on the petition. Indeed, the filing of the petition did not raise any procedural issue that the Office was required to resolve before the patent was granted.

The form of the entry in the PTA printout suggests that the 120-day delay was entered because the papers filed on that date were interpreted as a "late" filing. Patentee notes that one of the exhibits to the application for patent term adjustment under § 1.705(b) filed on that date was a copy of a previously-filed information disclosure statement (a "Supplemental

Information Disclosure Statement” originally filed on 28 April 2003). That exhibit may have been was incorrectly recognized as a new IDS, leading to the PAIR entry of a “miscellaneous paper” and the entry of applicant delay.

Conclusion

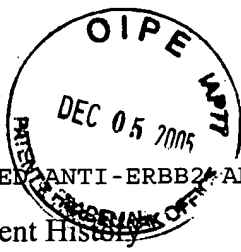
Patentee respectfully requests that the Director determine that the 120 days of applicant delay associated with the entry of a “miscellaneous paper” on 12 April 2005 was recorded in error, and that this patent is entitled to a total net PTA of +335 days.

Respectfully submitted,



David L. Fitzgerald, Reg. No. 47,347
Attorney for Genentech, Inc. (37 C.F.R. § 1.34)

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09/602,812 HUMANIZED ANTI-ERBB2 ANTIBODIES AND TREATMENT WITH ANTI-ERBB2 ANTIBODIES

Patent Term Adjustment History

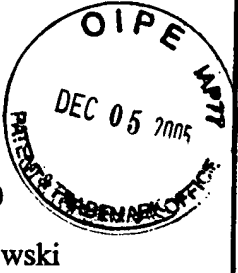
Patent Term Adjustment (PTA) for Application Number: 09/602,812			
			Days
Filing or 371(c) Date:	06-23-2000	USPTO Delay (PTO):	827
Issue Date of Patent:	09-27-2005	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay(APPL):	612
Post-Issue Petitions (days):	+0	Total PTA:	215
USPTO Adjustment(days):	+0	Explanation Of Calculations	
Patent Term Adjustment History			
Date	Contents Description	PTO(Days)	APPL (Days)
09-27-2005	Patent Issue Date Used in PTA Calculation	50	
09-07-2005	PTA 36 Months	574	
08-31-2005	Receipt into Pubs	↑	
08-31-2005	Dispatch to FDC	↑	
08-31-2005	Application Is Considered Ready for Issue	↑	
08-26-2005	Receipt into Pubs	↑	
08-18-2005	Petition Decision - Dismissed	↑	
08-18-2005	Petition Decision - Dismissed	↑	
04-12-2005	Miscellaneous Incoming Letter	↑	120
04-12-2005	Petition Entered	↑	↑
04-12-2005	Petition Entered	↑	↑
04-08-2005	Issue Fee Payment Verified	↑	
04-08-2005	Issue Fee Payment Received	↑	↑
02-16-2005	Sequence Forwarded to Pubs on Tape	↑	↑
02-02-2005	Workflow - File Sent to Contractor	↑	↑
01-12-2005	Mail Notice of Allowance	↑	↑
01-12-2005	Mail Examiner's Amendment	↑	↑
01-10-2005	Examiner's Amendment Communication	↑	↑
01-10-2005	Notice of Allowance Data Verification Completed	↑	↑
11-05-2004	Reference capture on IDS	↑	↑
11-05-2004	Information Disclosure Statement (IDS) Filed	↑	15
11-02-2004	Date Forwarded to Examiner	↑	↑
10-21-2004	Response after Non-Final Action	↑	↑
10-21-2004	Workflow incoming amendment IFW	↑	
10-06-2004	Mail Non-Final Rejection	4	
10-01-2004	Non-Final Rejection	↑	
08-26-2004	Information Disclosure Statement (IDS) Filed	↑	85
08-02-2004	Mail Examiner Interview Summary (PTOL - 413)	↑	↑
07-29-2004	Examiner Interview Summary Record (PTOL - 413)	↑	↑

06-10-2004	Date Forwarded to Examiner	↑	↑
06-02-2004	Response after Non-Final Action	↑	61
06-02-2004	Request for Extension of Time - Granted	↑	↑
06-02-2004	Workflow incoming amendment IFW	↑	↑
01-27-2004	Reference capture on IDS	↑	
01-27-2004	Information Disclosure Statement (IDS) Filed	↑	↑
01-02-2004	Mail Non-Final Rejection	159	
12-31-2003	Non-Final Rejection	↑	
11-18-2003	Reference capture on IDS	↑	
11-18-2003	Information Disclosure Statement (IDS) Filed	↑	236
05-06-2003	Date Forwarded to Examiner	↑	↑
05-06-2003	Supplemental Response	↑	↑
04-28-2003	Information Disclosure Statement (IDS) Filed	↑	↑
04-28-2003	Examiner Interview Summary Record (PTOL - 413)	↑	↑
03-27-2003	Date Forwarded to Examiner	↑	↑
03-27-2003	Response after Non-Final Action	↑	64
03-27-2003	Request for Extension of Time - Granted	↑	↑
02-27-2003	Information Disclosure Statement (IDS) Filed	↑	↑
10-22-2002	Mail Non-Final Rejection	↑	↑
10-21-2002	Non-Final Rejection	↑	
08-16-2002	Date Forwarded to Examiner	↑	
08-01-2002	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received	↑	
08-01-2002	Response after Non-Final Action	↑	31
08-01-2002	Request for Extension of Time - Granted	↑	↑
07-26-2002	Information Disclosure Statement (IDS) Filed	↑	
07-22-2002	Reference capture on IDS	↑	
07-22-2002	Information Disclosure Statement (IDS) Filed	↑	
07-17-2002	Reference capture on IDS	↑	
07-17-2002	Information Disclosure Statement (IDS) Filed	↑	
07-08-2002	Case Docketed to Examiner in GAU	↑	↑
04-01-2002	Mail Non-Final Rejection	↑	↑
02-25-2002	Non-Final Rejection	↑	
12-18-2001	Date Forwarded to Examiner	↑	
12-12-2001	Information Disclosure Statement (IDS) Filed	↑	
12-12-2001	Response to Election / Restriction Filed	↑	
10-02-2001	Mail Restriction Requirement	40	
10-01-2001	Requirement for Restriction / Election	↑	
04-12-2001	Information Disclosure Statement (IDS) Filed	↑	
01-29-2001	Information Disclosure Statement (IDS) Filed	↑	
10-31-2000	CRF Is Good Technically / Entered into Database	↑	
10-11-2000	Preliminary Amendment	↑	
10-10-2000	Case Docketed to Examiner in GAU	↑	
		↑	

09-28-2000	Application Dispatched from OIPE		
09-26-2000	Correspondence Address Change	↑	
09-02-2000	Information Disclosure Statement (IDS) Filed	↑	
09-01-2000	Reference capture on IDS	↑	
07-24-2000	CRF Is Flawed Technically / Not Entered into Database	↑	
07-17-2000	IFW Scan & PACR Auto Security Review	↑	
06-23-2000	CRF Is Good Technically / Entered into Database	↑	
06-23-2000	Initial Exam Team nn	↑	

Close Window

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For:	Humanized anti-ErbB2 antibodies and treatment with anti-ErbB2 antibodies			

TRANSMITTAL

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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a "Request for Reconsideration of Revision of Patent Term Adjustment under 37 C.F.R. § 1.705(d)" (7 pages, including attachments). If any additional fees are due, the Director is requested to charge our Deposit Account No. 18-1260.

Respectfully submitted,



David L. Fitzgerald, Reg. No. 47,347
Attorney for Genentech, Inc. (37 C.F.R. § 1.34)

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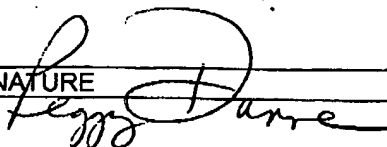
CERTIFICATE OF MAILING – 37 C.F.R. § 1.8

I hereby certify this correspondence, including:

- Transmittal (1 page)
- Request ... re Patent Term Adjustment (7 pages)

is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

SIGNATURE



PRINTED NAME

PEGGY DUNNE

DATE

11/28/05